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FITZPATRICK CELLA HARPER & SCINTO			SANTIAGO, LUIS F	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/576,533	Applicant(s) NAKAO ET AL.
	Examiner LUIS SANTIAGO	Art Unit 3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 13 October 2010.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.
- 4) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) Claim(s) 2, 4, 6, 8, 10 -13 is/are pending in the application.
- 5a) Of the above claim(s) None is/are withdrawn from consideration.
- 6) Claim(s) _____ is/are allowed.
- 7) Claim(s) 2, 4, 6, 8, 10 -13 is/are rejected.
- 8) Claim(s) _____ is/are objected to.
- 9) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 10) The specification is objected to by the Examiner.
- 11) The drawing(s) filed on 20 April 2006 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/CR/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

DETAILED ACTION

1. This office action is in response to applicant submission filed on October 13, 2010.

Continued Examination under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Currently claims 2, 4, 6, 8, 10 and 12 have been amended. Currently claims 2, 4, 6, 8, 10-13 are pending.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 4 and 10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedent¹ and recent Federal Circuit decisions, one factor to consider when determining if a claim recites a §101 patent eligible process is

¹ See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

whether the claimed process (1) is tied to a particular machine (or apparatus) or; (2) transforms a particular article to a different state or thing. See *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008) (en banc) *aff'd*, *Bilski v. Kappos*, 561 U.S. ___, 95 USPQ2d 1001 (U.S. 2010). The Examiner will call this test the Machine-or-Transformation Test ("M-T Test").

To meet prong (1) of the M-T Test, the method step should positively recite the particular machine to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite the material that is being changed to a different state or positively recite the subject matter that is being transformed. For example, a method claim that would probably *not* qualify as a statutory process because it fails the M-T Test would be a claim that recites purely mental steps.

In this particular case, in claim 4 applicant's method recite "a method implemented by a computer of controlling an information apparatus comprising: a registration step of registering a plurality of "schedules" each having a date set, in accordance with a user's operation; and a notification step of. The claim fail prong (1) because the registration step of registering a plurality of "schedules" each having a date set, in accordance with a user's operation" and the notification step of ... are not tied to a particular machine.

Further in claim 10 applicant's method recite "a notice method, implemented by a computer of providing notification. The claim fail prong (1) because the providing notification ... is not tied to a particular machine. Additionally, the claim fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

For additional guidance, see USPTO Memorandum² by Bahr, Robert W., Interim Guidance for Determining Subject Matter Eligibility for Process Claim in View of *Bilski v. Kappos*,³ July 27, 2010.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim 10 recites "a notice method, implemented by a computer of providing notification a schedule as to which no reminder has been given due to stop of a communication function even when a notice scheduled date has arrived in the function

² See MPEP §707.06 "Citation of Decisions, Orders Memorandums, and Notices" expressly authorizing the Examiner to cite to Commissioner's Memorandums which have not yet been incorporated into the MPEP.

³ Available at <http://www.uspto.gov/patents/law/exam/memoranda.jsp>

of notifying user of a schedule booked in an information apparatus". Note there isn't a transitional phrase to clearly identity the steps in that process claim. Clarification is required.

The transitional phrases "comprising", "consisting essentially of" and "consisting of" define the scope of a claim with respect to what unrecited additional components or steps, if any, are excluded from the scope of the claim. The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., > Mars Inc. v. H.J. Heinz Co., 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004).

The examiner interpreted the limitation of claim 10 "a notice method, implemented by a computer, **comprising**:

Providing notification a schedule as to which no reminder has been given due to stop of a communication function even when a notice scheduled date has arrived in the function of notifying user of a schedule booked in an information apparatus",

wherein when the notification function is started thereafter, schedule "as to which no reminder has been given and" which is included in "a set of" a predetermined number of schedules "that are most recent" before a date when the power supply is powered On set in the information apparatus, is communicated as a reminder,...

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 2 and 6 are rejected under U.S.C. 102(b) as being anticipated by Brakmo et al. (US 2003/0105983) (Hereinafter referred to as Brakmo).

With respect to **claim 2**:

Brakmo disclose an information power supply comprising a control unit which, when a notice "scheduled" date comes while said information power supply in a power-OFF status and then the power supply is powered ON, provides a notification of "schedule" "as to which a reminder has not yet been given and for which an indicated notice time is not more than a predetermined time in the past before a date when the power supply is powered ON, as a reminder, and does not notify provide any reminder as to a schedule as to which an indicated notice time is more than the predetermined time in the past before the date when the power supply is powered ON. "the processor periodically checks ... when a next scheduled event is set to take place; this check typically takes place when no processes are ready to execute, or when the processor enters an operating system idle loop, etc; scheduled events are normally indicated by timers, and the processor thus checks when the next timer is set to expire" (paragraph 0048); "the processor is powered up and is receiving a clock signal,...; various power

saving techniques may still be applied in this state though, i.e.... the processor voltage may be reduced" (paragraph 0045); "certain events, such as the expiry of an event timer (i.e. an appointment reminder or other scheduled event) or a user pressing a button may return the system to the running state" (paragraph 0047).

With respect to **claim 6**:

Brakmo disclose a computer-readable tangible storage medium storing program which causes a computer to execute: "the computer system includes a processor, non-volatile flash memory for permanent storage and boot up, volatile DRAM memory, a codec that provides an i/o interface to various input/output devices... (paragraph 0027).

a notification procedure of, when a notice "scheduled" date comes in a power-OFF status and then the power supply is powered ON, providing a notification of "schedule" "as to which no reminder has been provided, and as to which an indicated notice time is not more than a predetermined time in the past before a date when the power supply is powered On as a reminder; "certain events, such as the expiry of an event timer (i.e. an appointment reminder or other scheduled event) or a user pressing a button may return the system to the running state" (paragraph 0047); "the system performs any necessary actions before entering micro-sleep... (i.e. the display controller enters a static mode in which a fixed image is displayed), notifying any other device drivers that the processor will not be available for the sleep duration, and setting a timer to wake up the processor before the next scheduled event (i.e. at the end of the micro-sleep) (paragraph 0050) and

an un notification procedure of, when the notice "scheduled" date while the computer comes in the power-OFF status and then the power supply is powered ON, not providing a notification of the "schedule" as to which "the indicated notice time is more than" the predetermined time in the past before the a date when the power supply is powered On. "processor support for software controllable clock frequency, as well as two low-power modes: idle mode and sleep mode...most of the processor is unpowered, and only a real-time clock and a wake-up circuit remain enabled"...(paragraph 0036); "the system performs any necessary actions before entering micro-sleep... (i.e. the display controller enters a static mode in which a fixed image is displayed), notifying any other device drivers that the processor will not be available for the sleep duration, and setting a timer to wake up the processor before the next scheduled event (i.e. at the end of the micro-sleep) (paragraph 0050).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claim 4 is rejected under 35 U.S.C. 103 (a) as unpatentable over Brakmo et al. (US 2003/0105983) in view of Chen et al. (US 2004/0178987) (Hereinafter referred to as Chen).

With respect to **claim 4**:

Brakmo disclose a method implemented by a computer of controlling an information apparatus comprising:

a notification step of, when a notice "scheduled" date arrives while the information apparatus is in a power-OFF status and then the power supply is powered ON, providing a notification of any "schedule" as to which no reminder has yet been given, and as to which an indicated notice time is not more than a predetermined time before a date when the power supply is powered On, as a reminder, wherein, when a notice "scheduled" date comes in the power-OFF status and then the power supply is powered ON, "then in said notification step no notification is provided of any "schedule" whose indicated notice time is more than the predetermined time before the notice "scheduled" date" _providing a notification of a "schedule" as to which no reminder has yet been given, and as to which an indicated notice time is not more than a predetermined time before a date when the power supply is powered On. Brakmo, "certain events, such as the expiry of an event timer (i.e. an appointment reminder or other scheduled event) or a user pressing a button may return the system to the running state" (paragraph 0047); "the system performs any necessary actions before entering micro-sleep... (i.e. the display controller enters a static mode in which a fixed image is displayed), notifying any other device drivers that the processor will not be available for the sleep duration, and setting a timer to wake up the processor before the next scheduled event (i.e. at the end of the micro-sleep) (paragraph 0050).

Brakmo disclose the above limitation but do not disclose a registration step of registering a plurality of "schedules" each having a date set, in accordance with a user's operation.

However, Chen teaches "the variable function device may include a module for alerting or triggering the computer perform particular functions at, i.e., a scheduled time....the module includes a clock to permit the module to generate an event triggering signal to turn on the computer and permit the computer to perform, i.e., a scheduled event; also the computer may be switched from an off-state into an on-state in response to the event signal" (paragraph 0086).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention to have modified the system of Brakmo to have incorporated a registration step of registering a plurality of "schedules" each having a date set, in accordance with a user's operation as taught by Chen, since the output function module ... provide notifications (and/or warnings/alerts,... images, etc to a user; also the output stage may be, a display screen to display an alert message, etc (paragraph 0061).

10. Claims 8-13 are rejected under 35 U.S.C. 103 (a) as unpatentable over Brakmo et al. (US 2003/0105983) in view of Mastering Microsoft Office 97 (Hereinafter referred to as Moseley).

With respect to **claim 8**:

Brakmo disclose an information apparatus comprising at least a processor and memory which "operate to provide" a notification of an un notified schedule whose notice scheduled date registered in the apparatus comes while the apparatus is in a

power-OFF status, wherein an un notified schedule which is included in a set of a predetermined number of schedules "that are most recent" before a date when the power supply is powered On set in the information apparatus is communicated as a reminders when the apparatus is powered ON, "processor support for software controllable clock frequency, as well as two low-power modes: idle mode and sleep mode...most of the processor is unpowered, and only a real-time clock and a wake-up circuit remain enabled"...(paragraph 0036); "the system performs any necessary actions before entering micro-sleep... (i.e. the display controller enters a static mode in which a fixed image is displayed), notifying any other device drivers that the processor will not be available for the sleep duration, and setting a timer to wake up the processor before the next scheduled event (i.e. at the end of the micro-sleep) (paragraph 0050) and

Brakmo disclose the above limitation but do not disclose unnotified schedule which is not included in that set, is not communicated as a reminder.

However, Moseley teaches "the user can select or unselect the checkbox of reminder" (See Moseley, Fig. 35.5, page 787); "outlook is powerful information manager, have the capabilities as a mail manager, time scheduler, etc. In the mail folder the user can get to the user Inbox, Sent Items, outbox, etc" (See Moseley, Pages 755- 759).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention to have modified the system of Brakmo to have incorporated a registration step of registering a plurality of "schedules" each having a date set, in

accordance with a user's operation as taught by Moseley, since the user can select or unselect the checkbox of reminder. (See Moseley, Fig. 35.5, page 787).

With respect to **claim 10**:

Brakmo disclose a notice method, implemented by a computer of providing notification a schedule as to which no reminder has been given due to stop of a communication function even when a notice scheduled date has arrived in the function of notifying user of a schedule booked in an information apparatus, "certain events, such as the expiry of an event timer (i.e. an appointment reminder or other scheduled event) or a user pressing a button may return the system to the running state" (paragraph 0047); "the system performs any necessary actions before entering micro-sleep... (i.e. the display controller enters a static mode in which a fixed image is displayed), notifying any other device drivers that the processor will not be available for the sleep duration, and setting a timer to wake up the processor before the next scheduled event (i.e. at the end of the micro-sleep) (paragraph 0050).

wherein when the notification function is started thereafter, schedule "as to which no reminder has been given and" which is included in "a set of" a predetermined number of schedules "that are most recent" before a date when the power supply is powered On set in the information apparatus, is communicated as a reminder, "the processor periodically checks ... when a next scheduled event is set to take place; this check typically takes place when no processes are ready to execute, or when the processor enters an operating system idle loop, etc; scheduled events are normally

indicated by timers, and the processor thus checks when the next timer is set to expire" (paragraph 0048); and

Brakmo disclose the above limitation but do not disclose a schedule which is not included in that set, is not communicated as a reminder.

And, Moseley teaches "the events are distinguished from normal appointments; the calendar show events at the top of each day. (See Moseley, Page 792); "the user or customer can create appointments or meeting and specify the start and end time, the date and time and can indicate in advance you want to be reminded. (See Moseley, Page 787); (See Figs 35.3 and 35.4 show the schedule or task time in a different perspective and list to track our task").

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention to have modified the system of Brakmo to have incorporated a schedule which is not included in that set, is not communicated as a reminder as taught by Moseley, since the user can select or unselect the checkbox of reminder. (See Moseley, Fig. 35.5, page 787).

With respect to **claim 11**:

Brakmo disclose a notice method according to claim 10, wherein a stop status of a notification function is a status where an information apparatus is powered OFF, and the notification function is started when the information apparatus is powered ON. "the processor periodically checks ... when a next scheduled event is set to take place; this check typically takes place when no processes are ready to execute, or when the processor enters an operating system idle loop, etc; scheduled events are normally

indicated by timers, and the processor thus checks when the next timer is set to expire" (paragraph 0048); "if a user interaction occurs before the expiry of the micro-sleep period, the system returns to the running state and , the wake up timer that was set prior to entering the micro-sleep will return the processor to the running state just before the next scheduled event is set to take place, which will allow the next scheduled event to take place normally" (paragraph 0051).

With respect to **claim 12**:

Brakmo disclose a computer-readable tangible storage medium, storing a program which causes a computer to execute notification of a booked schedule and is directed for providing a notification function even when a notice scheduled date arrives, wherein when the notification function is started thereafter. "the computer system includes a processor , non-volatile flash memory for permanent storage and boot up, volatile DRAM memory, a codec that provides an i/o interface to various input/output devices...(paragraph 0027).

Brakmo disclose the above limitation but do not disclose a notification of a schedule as to which no reminder has been given due to stop of a notification.

And, Moseley teaches "the events are distinguished from normal appointments; the calendar show events at the top of each day. (See Moseley, Page 792); "the user or customer can create appointments or meeting and specify the start and end time, the date and time and can indicate in advance you want to be reminded. (See Moseley, Page 787); (See Figs 35.3 and 35.4 show the schedule or task time in a different perspective and list to track our task").

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention to have modified the system of Brakmo to have incorporated a notification of a schedule as to which no reminder has been given due to stop of a notification as taught by Moseley, since the user can select or unselect the checkbox of reminder. (See Moseley, Fig. 35.5, page 787).

a schedule as to which no reminder has been given and which is included in a set of a predetermined number of schedules most recent before a date when the power supply is powered ON set in an information apparatus, is communicated as a reminder. Brakmo teaches "certain events, such as the expiry of an event timer (i.e. an appointment reminder or other scheduled event) or a user pressing a button may return the system to the running state" (paragraph 0047) and

Brakmo disclose the above limitation but do not disclose schedule which is not included in that set, is not communicated as a reminder.

And, Moseley teaches "the events are distinguished from normal appointments; the calendar show events at the top of each day. (See Moseley, Page 792); "the user or customer can create appointments or meeting and specify the start and end time, the date and time and can indicate in advance you want to be reminded. (See Moseley, Page 787); (See Figs 35.3 and 35.4 show the schedule or task time in a different perspective and list to track our task").

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention to have modified the system of Brakmo to have incorporated a schedule which is not included in that set, is not communicated as a reminder as taught

by Moseley, since the user can select or unselect the checkbox of reminder. (See Moseley, Fig. 35.5, page 787).

With respect to **claim 13**:

Brakmo disclose a program according to claim 12, wherein a stop status of a notification function is a status where an information apparatus is powered OFF, and the notification function is started when the information apparatus is powered ON. "the processor periodically checks ... when a next scheduled event is set to take place; this check typically takes place when no processes are ready to execute, or when the processor enters an operating system idle loop, etc; scheduled events are normally indicated by timers, and the processor thus checks when the next timer is set to expire" (paragraph 0048).

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed Luis Santiago whose telephone number is (571) 270-5391. The examiner can normally be reached Monday to Friday from 8:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jasmin, Lynda can be reached on (571) 272-6782. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) System. Status Information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/LUIS SANTIAGO/

Examiner, Art Unit 3624

/LYNDA C JASMIN/

Supervisory Patent Examiner, Art Unit 3624